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REMARKS/ARGUMENTS

Favorable consideration of this application is respectfully requested. Applicant has rewritten claims 1-3, 13 and 14 and canceled claims 4-12. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks.

As to the restriction requirement, applicant has canceled nonelected claims 4-12, and reserves the right to file a divisional application on those unelected claims.

Claims 1-3 and 13-14 were rejected under sec. 112, second paragraph as being indefinite. Applicant has amended independent claims 1 and 13 to more clearly set forth the novel composition claimed components. Removal of the sec. 112, second paragraph rejection is respectfully requested.

Claims 1-3, 13 and 14 were rejected under sec. 103 as being unpatentable over the combination of U.S. Publication 2003/0007941("941), 2002/0119174('174), U.S. Patent 6,030,948('948), WO 96/25943('943) and U.S. Patent 6,376,557('557).

Applicant has amended independent claims 1 and 13 in the preamble to include a "composition" that is "...consisting essentially of...." Which the applicant has found to be a novel invention for "reducing hair loss and promoting hair life...."

Applicant strongly disagrees with the loose rejection combination of the five(5) cited references which together do not describe, teach or suggest the novel "composition" of the subject claims. Applicant disagrees with the office action statement that on page 6, where the "combination of the references does not teach the exact amounts of some ingredients...the claimed amounts do not impart patentability to the claims...." Applicant discovered the unique composition which included numerous testing and the novel results which followed which are described to on pages 8+ of the subject specification.

It is clearly improper for the examiner to arbitrarily ignore any of the novel features of the subject claims. Under the rules, if the applicant requests the examiner cite the reference(s) showing each and every one of the references that supports a rejection, the examiner must cite the reference or remove the rejection. Applicant requests the examiner specifically point out which uncited reference(s) describes and teaches these unsubstantiated opinions and assertions raised in the rejection that at least these features

are obvious under sec. 103. If actual references are not cited and supplied to the applicant to show these unsubstantiated opinions and assertions mentioned in their rejection, the applicant respectfully requests removal the 103 rejection for at least these reasons alone. Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. See *In re Hoch,* 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970). Thus, to maintain this rejection, the missing references must be cited and a nonfinal office action must be given since applicant has not seen these uncited references.

Applicant disagrees with the rationale cited for attempting to combine the five references of record. The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor's specification to make the necessary changes in the reference device. Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

There is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck,* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

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"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Applicant contends the references cannot be modified to incorporate the features of subject claims 1-3 and 13-14 without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

In view of the foregoing considerations, it is respectfully urged that claims 1-3 and 13-14 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully Submitted;

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